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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,308	03/29/2001	Usman A.K. Sorathia	82,222	7684

21

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Naval Surface Warfare Center
Carderock Division Headquarters
David Taylor Model Basin
9500 MacArthur Boulevard
West Bethesda, MD 20817-5700

EXAMINER	
FEELY, MICHAEL J	
ART UNIT	**PAPER NUMBER**
1712	

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.	Applicant(s)	
09/822,308	SORATHIA, USMAN A.K.	
Examiner	**Art Unit**	
Michael J Feely	1712	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.
8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because:

Applicants argue that no change in claim scope and new issues associated therewith are involved in the previously proposed Rule 116 Amendment. Specifically, Applicant argues that the sequential order of process steps is already embodied by recitation in the claims (prior to the 116 Amendment). The Examiner does not agree with statement.

In the version of the claims prior to the 116 Amendment, the process included "the improvement residing in a sequence of steps including:" This does not recite a specific sequence of process steps - it merely includes steps a), b), c), and d). It is agreed that step a) needs to take place before step b) and that step c) has to take place before step d); however, the language of step d) allows for the following sequences: 1) a-b-c-d; 2) a-c-b-d; 3) a-c-d-b; 4) c-a-b-d; and 5) c-a-d-b. Step d) is required to take place before completion of fabrication of the entire composite; therefore, it could be the very last step or it could be performed prior to step b. Step c) can be performed before or after steps a) and b); step b) can be performed before or after steps c) and d); and step a) can be performed before or after step c).

In the verson of claims submitted in the 116 Amendment, the process includes "performance in sequential order the following steps of" a), b), c), and d). There is only one sequecne possible: a-b-c-d. This limited sequence clearly changes the scope of the invention. As stated in the previous Advisory Action, this change in scope would require further consideration of the current references.

The proposed changes would overcome the rejections under 102(e); however, a new rejection under 103(a) would be required. The reasons for which, have been addressed multiple times in the case history. Namely, it has been found that, in the absence of unexpected results, a process of making a laminated sheet (composite structure) by reversing the order of process steps found in the prior art is an obvious variation of the prior art process - Ex Parte Rubin, 128 USPQ 440 (Bd.App. 1959). In Ex Parte Rubin, a prior art reference disclosing the process of making a laminated sheet wherein the base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material, was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.

The proposed rule 116 Amendment has not been entered, and the rejection of pending claims 17-20 stands for the reasons set forth in the Final Rejection.

Robert A. Dawson

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700